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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,667	10/17/2000	Steven MacWilliams	00725.0360-US-01	3418

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EXAMINER

CARTER, MONICA SMITH

ART UNIT PAPER NUMBER

3722

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,667

Applicant(s)

MACWILLIAMS, STEVEN

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 8, 30, 31, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham ('144).

Cunningham discloses a label for attaching over an edge of a stock (as seen in figures 1, 5, 6, and 8), the label comprises a substantially planar first layer (21, 22) having a first surface adapted to be printed on (as seen in figure 2) and a second surface (undersurface of 21, 22); a second layer (11) including a non-adhesive label material which is permanently attached to the second surface of the first layer (see col. 2, lines 26-31); the second layer having an adhesive on an outer surface of the non-adhesive label material (see col. 2, lines 23-26); the non-adhesive label material of the second layer having a first section (13) and a second section (14) having a gap therebetween (see col. 2, lines 5-20, Cunningham discloses a spacing between sections 13 and 14 along the center line of the second layer 11), the gap defining a fold-line section in the first layer (see col. 2, lines 12-17), the second layer covers substantially all of the second surface of the first layer (as seen in figure 2); the label folds along a fold line section such that a first section of the second layer is attachable

to a first side of the stock member and a second section of the second layer is attachable to a second side of the stock member (as seen in figures 5 and 8).

Regarding claim 8, Cunningham discloses that neither the first section nor the second section of the second layer bend when the folding pressure is applied to the label (as seen in figures 1 and 5).

Regarding claims 30-32 and 35, the method of applying the label to an edge of a stock member is disclosed in the above rejections.

Regarding claim 34, see the above rejections to claim 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 7 and 9-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham, as used above.

Cunningham discloses the claimed invention except for the fold-line section being off-set from a centerline of the first layer (claim 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to position the fold-line section along any desired location of the first layer, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claims 7 and 21, Cunningham discloses only one gap in the second layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any number of gaps in the second layer as desired by the end user, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 9-14, 21, 23, 29 and 33, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material having different characteristics such as color depending on the end result desired, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 15-17, Cunningham, discloses that the gap indicates a label fold-line in the first layer for matching with the edge of the stock member and the first layer folds along the fold-line section when a force is applied (as seen in figures 5 and 8).

Regarding claims 18-20 and 22-25, see the above rejections.

Regarding claim 26, Cunningham discloses the claimed invention as set forth above, except for the label having a backing member. It is commonly known to provide removable backing liners (such as silicone-based liners) to adhesive labels. It would have been obvious to one having ordinary skill in the art to provide a backing member to

the label of Cunningham to provide a protective covering for the adhesive layer and then remove the covering when the label is to be applied to a stock material.

Regarding claim 27, Cunningham discloses one or more label members attached to the at least two sections of the second layer (as seen in figures 6 and 8).

Regarding claim 28, Cunningham discloses each of the label members having a perimeter edge which matches an edge of the at sections of the second layer (as seen in figure 6).

Response to Arguments

5. Applicant's arguments filed February 23, 2004 have been fully considered but they are not persuasive.

Applicant argues that Cunningham fails to disclose the layers being planar. The examiner maintains that, as claimed, Cunningham discloses the first layer (21, 22) being "substantially planar". As seen in figure 3, the layer *is* substantially planar.

Applicant argues that Cunningham does not recognize nor solve the problem of the present invention. In response to applicant's argument that it would be impossible to use Cunningham's device in typical sheet-feed printers, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it

meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

For the reasons as set forth above, the rejections are maintained.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

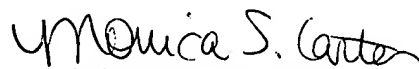
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 11, 2005


MONICA S. CARTER
PRIMARY EXAMINER